

### **REMARKS**

This amendment is submitted along with a Request for Continued Examination and appropriate fee in reply to the final Office Action dated July 25, 2007. Claims 11-37 currently stand rejected. Applicants have amended independent claims 11, 16, 31 and 33-37 to more particularly distinguish the claimed invention from the cited references. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

### **Claim Rejections - 35 USC §101**

Claims 33 and 37 currently stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants respectfully traverse.

Independent claims 33 and 37 each are directed to an apparatus comprising a server comprising a processing element configured for the performance of various claimed functions. In other words, independent claims 33 and 37 are directed to a server device that includes a processor configured to perform various functions. The final Office Action rejects independent claims 33 and 37 on the basis that they lack any functional structure of an apparatus. In fact, somehow the final Office Action believes the above recitation is a recitation of software per se, and is therefore not statutory. Applicants disagree with this analysis.

As an initial matter, Applicants respectfully point out that the claims at issue are directed to a server, which is clearly an apparatus having certain inherent characteristics and corresponding structure. In this regard, a processor and circuitry of a computer are inherent structural characteristics of the server. Moreover, as stated by the court in *The Massachusetts Institute of Technology v. Abacus Software*, 462 F.3d 1344 80 U.S.P.Q.2D (BNA) 1225 (Fed. Cir. 2006), with regard to determinations of sufficient structure, “we have held that it is sufficient if the claim term is used in common parlance or by persons of skill in the art to designate structure, even if the term covers a broad class of structures and even if the term identifies the structures by their function” citing *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1359-60 (Fed. Cir. 2004). Accordingly, the claimed apparatus of independent claims 33

includes structure inherent in a server to perform the recited functions. Thus, the recitation of the server, which is defined by Webster's II New College Dictionary Third Edition (2005) as a "computer that processes requests for HTML and other documents that are components of web pages", would clearly be used in common parlance by persons of skill in the art to designate the corresponding structure of a computer. Since the structure of a computer is well known and includes a processing element, which may be configured to perform functions, independent claims 33 and 37 clearly recite an apparatus having functional structure and are statutory.

In light of the remarks above, Applicants respectfully submit that the rejections of claims 33 and 37 under 35 U.S.C. §101 are overcome.

**Claim Rejections - 35 USC §112**

Claims 33 and 37 also currently stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the final Office Action asserts that the claimed feature of a "processing element" is not disclosed in the specification. Applicants respectfully traverse.

As stated above, a processor and circuitry of a computer are inherent structural characteristics of the server. Thus, by virtue of disclosing the server, Applicants have inherently also disclosed a processing element, which is a well known component of a server.

Accordingly, Applicants respectfully submit that the rejections of claims 33 and 37 under 35 U.S.C. §112, first paragraph, are overcome.

**Claim Rejections - 35 USC §103**

Claims 11-37 currently stand rejected under 35 U.S.C. §103(a), as being unpatentable over Dusse et al. (U.S. Patent No. 6,647,260, hereinafter "Dusse") in view of Routtenberg et al. (U.S. Patent Application Publication No. 2002/0049717, hereinafter "Routtenberg").

Independent claim 11 recites, *inter alia*, requesting media content from a mobile station, temporarily saving the media content within the mobile station, and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content. Thus, according to an

embodiment as recited in independent claim 11, the same media content that is requested is temporarily saved and a portion of the same media content, more specifically a portion that was itself specifically requested, is previewed. In other words the claimed invention requires that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station.

The final Office Action alleges that the above-recited features are disclosed at col. 8, lines 35-47 of Dusse, except that Dusse does not disclose that the previewed portion is a specifically requested portion of the media content. However, the final Office Action continues to allege that Dusse's disclosure of terms, conditions and related information being pushed to the mobile station corresponds to the above recited features with the exception of not being specifically requested, which deficiency the Office Action asserts is cured by Routtenberg. This analysis is respectfully traversed.

Applicants respectfully note that the Office Action cites Dusse at page 4 as disclosing content and related notifications at col. 7, lines 60-62. The final Office Action further states that Dusse discloses that terms, conditions, and related notifications are pushed to the mobile station after approval by the user until previewed and accepted at col. 8, lines 34-38. The Office Action therefore surmises that the terms, conditions and related notifications must be temporarily stored within the mobile terminal until previewed by the user and that "media content" may be interpreted to include the terms, conditions and related notifications in addition to the content that was specifically requested. However, as previously explained by the Applicants, the previewed portion of the media content which is stored in the mobile terminal according to the claimed invention is itself specifically requested. As admitted by the final Office Action, the terms, conditions and related notifications of Dusse are not themselves specifically requested. Thus, the terms, conditions and related notifications do not correspond to the claimed portion of the media content. Accordingly, the content disclosed by Dusse, which has clearly been shown to lack correspondence to that which is claimed, should no longer be relied upon with respect to the processing it undergoes since the lack of correspondence between the content upon which Dusse operates and that of the claimed invention creates further gaps between Dusse and the claimed invention which have not been appreciated by the Examiner.

In this regard, Dusse fails to teach or suggest more than just that the portion of the media content that is previewed was specifically requested. Rather, Dusse fails to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. In other words, Dusse fails to teach or suggest that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station in which the portion was specifically requested.

Routtenberg is directed to a digital content distribution method in which, according to a first embodiment, content is distributed to a content storage device where temporary access may be granted to a user. If the user selects to purchase the content, with a button push, the user may be enabled to permanently write the content to a self-contained removable digital storage medium such as a CD or DVD. In a second embodiment, an access device separate from a storage device may be given either temporary or permanent access based whether the user has purchased the content. Thus, in the first embodiment of Routtenberg, the media content is never stored in the mobile station, but instead is stored at an external self contained removable storage medium. Similarly, in the second embodiment of Routtenberg, the media content is not stored in the mobile station at all, but is instead stored at a storage device that provides controlled access to the user. Therefore, Routtenberg fails to cure the above described deficiency of Dusse since Routtenberg never temporarily stores the media content in the mobile terminal. Thus, the media content of Routtenberg that is previewed is not content which was previously stored in the mobile station. Accordingly Routtenberg also fails to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11, since Routtenberg fails to teach or suggest that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station in which the portion was specifically requested.

Independent claims 16, 31 and 36 include similar subject matter to that of independent claim 11 at least with respect to temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. Accordingly, independent claims 16, 31 and 37 are patentable for at least the same reasons given above for independent claim 11.

Additionally, since the previewed portion of the media content of the claimed invention is a portion of media content that is not only specifically requested, but also stored within the mobile station, both Routtenberg and Dusse fail, either individually or in combination, to teach or suggest previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. Independent claims 33-35 and 37 include similar recitations with regard to this feature and thus are patentable for at least the same reasons given above in relation to independent claim 11.

Despite the reasons given above for the patentability of the claimed invention, Applicants respectfully note that some of the independent claims include yet further novel and nonobvious features with respect to Dusse and Routtenberg. In this regard, independent claim 11 has also been amended to recite, *inter alia*, permanently saving the media content within the mobile station only when permission to save has been received from the server.

The Office Action alleges that the above recited feature is disclosed by Dusse at col. 7, lines 32-40 and col. 8, lines 35-47. However, col. 7, lines 32-40 of Dusse, only discloses saving content relating to device features and services that match requested features or services and there is no indication whatsoever in this passage of any requirement of receiving permission to save the content as recited in independent claim 11. The Office Action further asserts that col. 8, lines 35-47 of Dusse refers to user acceptance of the terms, conditions and related information, which the Office Action interprets as constituting "permission to save". However, as indicated above, independent claim 11 clearly recites that the permission to save within the mobile station is received from the server. Accordingly, Dusse fails to teach or suggest permanently saving the

media content within the mobile station only when permission to save has been received from the server as recited in independent claim 11.

The final Office Action asserts that the feature above is disclosed by Routtenberg at paragraphs [0042] and [0048] by virtue of the server communicating successful billing to the user for purchased content files (see final Office Action page 5). However, as indicated above, in the first embodiment of Routtenberg, the media content is never stored in the mobile station, but instead is stored at an external self contained removable storage medium. Similarly, in the second embodiment of Routtenberg, the media content is not stored in the mobile station at all, but is instead stored at a storage device that provides controlled access to the user. Thus, Routtenberg also fails to teach or suggest permanently saving the media content within the mobile station only when permission to save has been received from the server as recited in independent claim 11.

Independent claims 16, 31 and 36 recite substantially similar subject matter to that of independent claim 11 with respect to permanently saving the media content within the mobile station only when permission to save has been received from the server and are therefore patentable for at least the same reasons given above for independent claim 11 with respect to this feature. Independent claims 33-35 and 36 each describe the transmission of a confirmation reply message to grant permission for the mobile station to permanently store the media content within the mobile station. Dusse is cited as disclosing this feature at col. 7, lines 32-40 and col. 8, lines 35-47. However, Dusse fails to teach or suggest this feature for the same reasons discussed above and Routtenberg fails to cure the deficiency of Dusse and is not cited as such. Thus, Routtenberg and Dusse, alone or in combination, also fail to teach or suggest this feature.

Independent claims 11, 16, 31 and 33-37 also describe sending or receiving a primitive with the mobile identification number of the mobile station. This feature is neither taught nor suggested in any of the cited references. In this regard, Dusse discloses sending a notification to a billing center at col. 6, lines 55-57, but there is no indication that the notification includes the mobile identification number. Routtenberg does not include any disclosure in this regard, and is not cited as such. Accordingly, the combination of Dusse and Routtenberg fails to teach or suggest sending or receiving a primitive with the mobile identification number of the mobile

station as recited in the claimed invention. Furthermore, independent claim 11 further recites, receiving, at the mobile station, permission to save said media content in response to receipt of the primitive at said server, which is neither taught nor suggested in Dusse or Routtenberg or by the combination thereof.

For all the reasons above, Applicants respectfully submit that independent claims 11, 16, 31 and 33-37 are patentable over the Dusse and Routtenberg, alone or in combination. Claims 12-15, 17-30 and 32 depend directly or indirectly from independent claims 11, 16 and 31, respectively, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 12-15, 17-30 and 32 are patentable for at least the reasons given above for independent claims 11, 16 and 31.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 11-37 are overcome.

**CONCLUSION**

In view of the amendment and remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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